

REMARKS

By this amendment, claims 60-76 are cancelled without prejudice, and claims 77-90 are newly added. Therefore, claims 77-90 are pending in the application.

This amendment is fully supported by the specification to the application and does not include any new matter. Reconsideration and allowance of all claims are respectfully requested in view of the following remarks. The pending claims set forth a novel and non-obvious advance in fish-landing nets – for the first time bringing convenient lighting features to large yet compactly-stored fish-landing nets (i.e., nets of the type having telescoping handles and/or collapsible frames which, prior to this invention, would be thought as not accommodating convenient lighting features).

The amended claims are fully supported by the specification and do not include any new matter. Independent claims 77 and 86 are provided in a Jepson format in order to better focus on the novelty of the subject claims. More specifically, independent claim 77 and its dependent claims focus on placement of an LED illuminator at the distal end of the last section of a multi-section telescoping handle. Independent claim 86 and its dependent claims focus on conveniently located rotary switch feature, with claims 87 and 88 focusing on aspects of the engagement of the LED illuminator with the distal end of the handle while 89 and 90 add the telescoping and collapsible features which render unobvious the use of a lighting structure at the distal end of the handle.

In the Office Action of April 24, 2006, claim 62 was objected to based on an imformality. Claim 62 has been cancelled and the informality has been eliminated.

Claim 60, 63-68, 73 and 75 were rejected under 35 USC §103(a) as being obvious over Blaschke in view of Yen and Nadel. These claims have been cancelled and are replaced by the claims noted above, which are patentably distinct over the cited art. (See discussion below.)

Claim 61-62 and 74 were rejected under 35 USC §103(a) as being obvious over Blaschke in view of Yen and Nadel and further in view of Wallin. These claims have been cancelled and are replaced by the claims noted above, which are patentably distinct over the cited art. (See discussion below.)

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Claim 69-72 were rejected under 35 USC §103(a) as being obvious over Blaschke in view of Yen and Nadel and further in view of Hansen. These claims have been cancelled and are replaced by the claims noted above, which are patentably distinct over the cited art. (See discussion below.)

Claim 76 was rejected under 35 USC §103(a) as being obvious over Wallin view of Yen. This claim has been cancelled and is replaced by the claims noted above, which are patentably distinct over the cited art. (See discussion below.)

In the April 24, 2006 Office Action and the July 19, 2006 Advisory Action, the Examiner combined the Blaschke, Yen, Nadel and Wallin references. The Blaschke reference discloses a collapsible fishing net. Blaschke teaches a collapsing net tool 10 including an extended hinged loop net frame 12 attached to a handle head 20. The extended hinged loop net frame 12 is composed of a plurality of hinged members 12A which in a collapsed state retract into the distal end of the handle. A number of different mechanisms for extracting and retracting the net from/into the handle. The extraction mechanism relevant to the present inquiry is the motorized mechanism 68 depicted in FIG. 8 which includes a light 76. The motor is located at the proximate end of the handle 16 whereas the net 12 is attached to the distal end.

It is important to note that the above-noted collapsibility-into-the-handle feature would plainly be thought to rule out useful placement of lighting apparatus at the distal end of the handle. The same principle applies with respect to telescoping handle, given that by their very nature they involve using the handle space for purposes relating to compact storage, thus teaching away from the idea of reasonable placement of lighting apparatus at that location. In Blaschke, placing a light in the distal end of the handle would not be possible because the net is retracted into the handle; a light at that location would destroy the central purpose of Blaschke, and the same thinking would apply for telescoping handles.

Since the Blaschke device would be rendered inoperable by the Examiner's proposed modification, there would have been no suggestion or motivation. *In re Gordon*, 221 USPQ 125 (Fed. Cir. 1984) (A proposed modification cannot render the prior art unsatisfactory for its intended purpose.); MPEP 2143.01.

One reason that same general logic applies with respect to nets with telescoping handles is that retracting of the telescoping sections inside one another would be thought by persons of ordinary skill in the art to present engineering problems that would interfere with the telescoping action, or that the telescoping action would interfere with electrical connections. Providing applicants' invention as forth in claims 77-85 and 89-90 would fall well outside the ability of one of ordinary skill in the art at the time of the invention.

The Examiner combined Blacshke with the Yen reference which relates to a high-powered LED flashlight having a heat dissipation device. The Yen high-powered LED luminary causes the temperature-related problem near the LED and requires a heat dissipating device which prevents from heat accumulation. Yen's flashlight includes a single high intensity LED 21 and an on/off switch 27. See FIG. 3. The Yen flashlight may not be placed in the distal end of the handle, since positioning of the Yen flashlight inside anything will cover the heat sinks essential for operation of the Yen device, thus subjecting the device to damage and diminution of use life.

The Yen reference fails to disclose or suggest a rotary switch lens cap rotatably attached to the light body and having a light passage portion for passing light from the LED therethrough. Yen teaches an on/off switch 27 at the proximate end of the flashlight whereas the high intensity LED is located at the distal end. See FIG. 3. This is not an inadvertent design choice since the high intensity LED 22 is sufficiently hot so as to require a special heat sink (the essential purpose of Yen's invention) making it too hot to have a rotary lens switch. The Examiner's assertion with respect to a rotary switch lens 22-24 is misplaced. Yen clearly discloses that the switch is element 27 and that reference numerals 22-24 are a reflector, a base, and a housing respectively.

The modification proposed by the Examiner (i.e., apparently the removal of housing 24 from casing 26) would eliminate the functionality of switch 27 of Yen, rendering that corresponding switch operation unsatisfactory for its intended purpose. In yet another example, Yen cannot be modified to be "a light body insertable into a distal end of the shaft," as claimed because such would render the heat dissipation operation of Yen unsatisfactory by covering up heat sinks 241 if such are inserted into a barrel 8 of Wallin.

In addition, the cover set 25 of Yen engages the housing 24, thereby being a separate piece; there is no disclosure of a lens in cover set 25 and cover set 25 is not a rotary switch lens for on/off switching of an LED in a light body. Although prior art of Figure 1 therein has a lens cover 15 with a lens, the Fig. 3 device and corresponding description do not disclose a lens. Further, the Figure 1 lens cover 15, when rotated, would only serve to loosen lens cover 15 and its lens from their attachment to housing 14.

Nadel does not cure the above-identified defects of Yen regarding the rotary switch or the attachment of a self-contained light body to one of the net and the net attachment section, features of the claimed invention. Furthermore, applicants need not comment on aspects of the combinations related to the disc-type battery because no present claims include that feature.

Wallin discloses a fish dip net having an elongate handle with a switch near a proximal end and a light and a net at a distal end of the handle. The conductor wire is extending through the handle body connecting the flashlight head assembly at the distal end of the handle and the switch near the proximal end. Such configuration would not allow for telescoping collapsing of the handle because the wiring inside the handle would interfere with sliding of the telescoping sections or become damaged by getting caught between the telescoping sections. Furthermore, the Wallin design calls for such a construction that will float horizontally in water. Making telescoping handle floatable in the water would require modification so significant that it would fall outside the skill possessed by one of ordinary skill in the art.

The Wallin device would be rendered inoperable if modified as proposed by Examiner. *In re Gordon, supra.* In one example, an important object of Wallin is for the illuminating means to be waterproof and adapted to function while submerged (e.g., 1: 12-15). To accomplish this object, sealing elements or gaskets 15, 42, etc. permit the device to function while submerged in addition to protecting the parts thereof from damage from water or moisture (e.g., 2: 48-51). Such water protection and waterproof operation would be rendered unsatisfactory by somehow attempting to rotate housing 10 or portions thereof as a rotary switch. In addition, it appears that rotation of lens 17 or its retaining ring 18 would not effect any switching.

In another example, Wallin includes a slidable thumb switch 32 having a contact 30

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connected to contact 26 of socket 21 via wire 31 (e.g., 2: 9-11, 18-20), thereby allowing the intended operation as an independent flashlight having a thumbswitch (e.g., 1: 18-19), and such would be rendered inoperable by a modification that removes a thumbswitch from barrel 8 (e.g., by use of a switch in an insertable module) and by a modification that breaks a fixed connection of wire 31 and socket contact 26 (i.e., as proposed by the Examiner's statement).

No comment need be made with respect to the Hansen reference, given that previous claim elements that prompted citation of Hansen are not included in the present claims.

The combination of several references can be said to involve improper hindsight analysis, because selected parts of the individual references are cited without consideration of the invention as a whole (emphasis added). *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) (“impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art”). There is nothing in the several cited references which would reasonably suggest the claimed combinations – particularly as set forth in the claims now presented. Since the claimed invention as a whole, is not taught or suggested by the applied references, Applicants respectfully request allowance of claims 77-90.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. The Examiner is invited to call the undersigned attorney to resolve any points that might remain in issue.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 10-0270.

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Respectfully submitted,



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